



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,553	09/22/2003	Solomon Emeth	70203.010300	9994

33717 7590 05/11/2005

GREENBERG TRAUIG LLP
2450 COLORADO AVENUE, SUITE 400E
SANTA MONICA, CA 90404

EXAMINER

HOEY, ALISSA L

ART UNIT	PAPER NUMBER
----------	--------------

3765

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,553

Applicant(s)

EMETH, SOLOMON

Examiner

Alissa L. Hoey

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-31 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-29 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This is in response to RCE received on 04/24/05. Claims 1-21 are cancelled and claims 22-31 are pending herein.

Election/Restrictions

2. This application contains claims directed to the following patentably distinct species of the claimed invention: a removable billboard panel attached to the front (claim 30) of a garment and a removable panel attached to the back (claims 22 and 29) of a garment.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 31 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 3765

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Louis Bovasso on 05/02/05 a provisional election was made without traverse to prosecute the invention of a removable billboard panel attached to the back of the garment, claims 22-29 and 31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 30 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

I) In claim 22, no antecedent basis in the specification for "defined *solely by four interconnecting boarders*".

II) In claim 22, no antecedent basis in the specification for "said panel being secured to said back panel of said main body portion *solely* by said quick release fasteners".

III) In claim 29, no antecedent basis in the specification for "said billboard panel having a back surface *abutting*, against said back panel..."

IV) In claim 29, no antecedent basis in the specification for "a removable billboard panel *substantially covering* said back panel".

V) In claim 29, no antecedent basis in the specification for "said billboard panel being held against the back panel *solely* by said quick release fasteners..".

VI) In claim 31, no antecedent basis in the specification for "...secured to one side *solely* by a plurality of spaced interconnecting quick release means..."

Claim Objections

5. Claim 23 is objected to because of the following informalities: "a first mating elements" is plural and "a second mating element" is singular. They should both be singular or plural to avoid confusion. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Rassner (US 2,647,261).

In regard to claim 31, Rassner teaches a garment (10) having a main body portion with a front and back side adapted to be worn by an individual for presenting a removable billboard display to a viewer (figures 1 and 3). A billboard display (36)

Art Unit: 3765

removably attached to one side of the main body portion the display having indicia on one side thereof away from the one side and removably secured to the one side solely by a plurality of spaced interconnecting quick release means (33, 41, 39). The quick release means normally covered by flap means (21) encircling at least a portion of the billboard display (figure 1). The flap means having an underside with the quick release means thereon (figure 2, identifier 27).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 22, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Counter (US 5,813,051).

In regard to claim 22, Counter teaches a garment (10) adapted to be worn by an individual and adapted to cover the individual's upper torso (10). The garment having a main body portion with a back panel. The garment comprising a plurality of flaps (22, 24) integral with the garment and forming a border about at least a portion of the back panel (20). Each of the flaps (22, 24) having a flat appearance and a first side engaged with the garment (34, 28) and second free side spaced from the first side (26, 32). The flaps (22, 24) having an outer facing surface and an inner facing surface overlying the back panel (column 3, lines 19-25). A plurality of quick release fasteners (30, 36) disposed on the inner surface of the flaps (22, 24) and spaced from the free side and thereby hidden

Art Unit: 3765

from view by the outer facing surface of the flaps (column 3, lines 19-25). A removable billboard panel (12) having four interconnected borders covering at least a portion of the back panel (20), the billboard panel (12) having a back surface overlying the back panel and a front surface having indicia thereon (46). The flaps (22, 24) overlying a portion of the billboard panel (12) front surface and said billboard panel front surface further including a plurality of quick release fastener (52, 57) for cooperating with and engaging the quick release fasteners on the inner surface of the flaps (30, 36). The billboard panel being secured to the back panel of the main body portion by the engaged quick release fasteners and having an outwardly visible front surface with the indicia defined by either the borders or the flaps (figures 1-4).

In regard to claim 28, Counter teaches the mating elements comprising patches of mating hook and loop material (column 2, lines 46-67).

In regard to claim 29, Counter teaches a garment (10) adapted to be worn by an individual and adapted to cover the individual's upper torso. The garment comprising a main body portion having an integral back panel (20). A plurality of flaps (22, 24) integral with the garment and forming a border about at least a portion of the back panel, each of the flaps having a flat appearance and a first side fixed to the garment and a second free side spaced from the first side (figure 4, identifies 22, 24). The flaps having an outer facing surface and an inner facing surface overlying the back panel (figures 3 and 4, identifies 22, 24). A plurality of quick release fasteners (30, 36) disposed on the inner surface of the flaps and spaced from the free side and thereby hidden from view by the outer facing surface of the flaps (figures 3 and 4). A removable

Art Unit: 3765

billboard panel (12) covering the back panel between the flaps and the billboard panel having a back surface abutting against the back panel and a front surface having indicia thereon (figures 3 and 4). The flaps overlying a portion of the billboard panel and the billboard panel front surface further including a plurality of quick release fasteners (52, 57) for cooperating with and engaging the quick release fasteners on the inner surface of the flaps (30, 36). The removable billboard panel (12) being secured to the main body portion by the engaged quick release fasteners on the flaps and the removable panel and having an outwardly visible front surface with indicia thereon defined by the second free sides of the flaps thereby forming a peripheral border partway around the removable billboard panel (Figure 4). The billboard panel (12) being held against the back panel by the cooperating quick release fasteners on the flaps and the removable panel so that another removable panel can be substituted for the first mentioned removable panel (column 1, lines 12-16).

However, Counter fails to teach the panel being secured solely by the quick release fastening means and the billboard comprised solely by four interconnected borders.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have provided the panel being secured solely by the quick release fastening means and the billboard comprised solely by four interconnected borders because Applicant has not disclosed that the panel being secured solely by the quick release fastening means and the billboard comprised solely by four interconnected borders provides an advantage, is used for a particular

Art Unit: 3765

purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the billboard panel being secured solely by the quick release fastening means or being secured by quick release fastening means in addition to another fastening mechanism because as long as the billboard panel is removable and interchangeably secured to the garment the amount of attachments is not essential to the invention. Further, Applicant's invention would perform equally well with the billboard panel comprised solely by four interconnected boarders or a billboard panel that is comprised of four interconnected boarders and a strap because as long as the billboard panel is removable and interchangeably secured to the garment the billboard panel's constitution is not essential. Therefore, it would have been an obvious matter of design choice to modify Counter to obtain the invention as specified in claims 22 and 29.

Further, Counter fails to teach the removable billboard panel substantially covering the back panel.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have provided the billboard panel substantially covering the back panel because Applicant has not disclosed that the billboard panel substantially covering the back panel provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the billboard panel substantially covering the back panel or just covering part of the billboard panel because as long as the garment has a removable billboard panel

Art Unit: 3765

overlying the billboard panel the amount of the back portion the billboard panel overlies is not essential. Therefore, it would have been an obvious matter of design choice to modify Counter to obtain the invention as specified in claim 29.

In regard to claim 28, Counter teaches the mating elements comprising patches of mating hook and loop material (column 2, lines 46-67).

10. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Counter in view of Rassner (US 2,647,261).

Counter teaches a garment with removable billboard panel as described above in claim 22. However, Counter fails to teach the first flap of the plurality of flaps extending along the upper portion of the back of the garment.

In regard to claim 23, Rassner teaches a first flap (21) extending along the upper portion of the back of the garment (17).

In regard to claim 24, Counter teaches the quick release fastener including a plurality of sets of mating elements, each set including a first mating element adapted to be releasably secured to a second mating element (column 2, lines 46-67).

In regard to claim 25, Counter teaches the first mating elements (30, 36) are provided on the underside of the flaps (22, 24).

In regard to claim 26, Counter teaches the second mating element (52, 57) being provided on the side of the billboard panel away from the back of the garment (20).

In regard to claim 27, Counter teaches the flaps (22, 24) normally covering the first and second mating elements when the billboard panel is removably secured to the garment (column 3, lines 19-26).

It would have been obvious to have provided the removable billboard garment of Counter with the flap extending along the top of the garment of Rassner, since the removable billboard garment of Counter provided with a flap extending along the top of the garment would provide the billboard panel to be attached to the garment more securely and protecting the top edge of the billboard panel from getting caught on other objects.

Conclusion

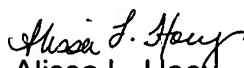
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Froehlich, Hall, Feldman, and Rubin are all cited to show closely related garment articles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (571) 272-4985. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (571) 272-4983. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3765

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Alissa L. Hoey
Patent Examiner
Technology Center 3700